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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,839	04/21/2000	Miriam Mawle	06181-862002	6339
26171	7590	12/18/2003	EXAMINER	
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			WHITE, CARMEN D	
			ART UNIT	PAPER NUMBER
			3714	16
DATE MAILED: 12/18/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/556,839

Applicant(s)

MAWLE ET AL.

Examiner

Carmen D. White

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-39 is/are allowed.
- 6) ☒ Claim(s) 1-33 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 4, 2003 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 7-33 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sharpe** III et al in view of **Gabai** et al, in view of **Gilboa** (5,853,327).

Regarding claims 1-3, 5, 7-33 and 40, Sharpe and Gabai teach all the limitations of the claims as discussed in the previous office actions (see papers #5 and 8), which are incorporated herein by reference. In response to the addition of the feature of providing a representation of the toy figure when the first and second game systems communicate with the toy, Gilboa teaches the feature of providing a representation of the toy figure when the toy figure is in communication with the game system (abstract; col. 3, lines 15-43; col. 4, lines 19-20, lines 23-25 and lines 41-45). It would have been

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obvious to a person of ordinary skill in the art at the time of the invention to employ this feature, as taught by Gilboa, in Sharpe and Gabai to make the game more realistic and fun for smaller children.

Claims 4 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over **Sharpe** III et al in view of **Gabai** et al, further in view of **Gilboa** (5,853,327), further in view of **Kikinis**.

Regarding claims 4 and 6, Sharpe, Gabai and Gilboa, teach all the limitations of the claims as discussed above. Regarding the features of the mating connector and inductive or capacitive coupling connections, Kikinis teaches these features (see prior office action, paper #8, which is incorporated herein by reference). It would have been obvious to a person of ordinary skill in the art a the time of the invention to incorporate these features as taught by Kikinis, in the game systems of Sharpe, Gabai and Gilboa, to enhance the communication between the gaming system and the toy figure; thereby improving game output.

Allowable Subject Matter

Claims 34-39 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the cited prior art, Sharpe, Kikinis, Gabai and Gilboa do not teach the features *of receiving input from a user through the input mechanism independently of communication with the toy and controlling the representation of the toy when the game system communicates with the toy based on the received user input.*

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Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lam, Shackelford and Collins et al teach interactive gaming systems that employ toy figures.

Examiner's Response to Applicant's Remarks

Applicant argues that Sharpe, Gabai and Kikinis do not teach the newly added feature of providing a representation of the toy figure when the game system communicates with the toy figure. The examiner has cited Gilboa to teach this feature. Therefore, Applicant's arguments are now moot in light of the new claim rejections.

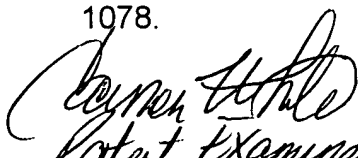
USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-

1078.


Patent Examiner, 3714
cdw